

hypobromite has a chance to degrade. Note that the stabilized biocidal composition of this invention has a high active bromine content, at least about 100,000 (wt/wt), see Claim 64.

On April 17, 2001, Applicants' filed an Amendment Under 37 C.F.R. §1.607. Claims 61-65 were submitted in order to have an interference declared between the subject application and U.S. 6,156,229. The claims sought to be designated as corresponding to a proposed Markush count are Claims 61-65 of the instant application and Claims 10-17 of U.S. 6,156,229.

Claim 10 of the '229 patent recites a process for producing a stable oxidizing compound which comprises adding bromine to a caustic solution prepared from a halogen stabilizer (sulfamic acid), water and an alkali or alkaline earth metal hydroxide. This is the same order of addition as is recited in Applicants' claims. Plainly there is overlapping subject matter disclosed and claimed in both the present pending application and in the issued '229 patent, thus warranting an interference to determine which, if any, of the respective patent rights should prevail in a contest between the parties.

During prosecution of the '229 patent, the Examiner rejected Claim 10 under 35 U.S.C. 103(a) over Goodenough et al. This is the very same rejection leveled against Claims 61-65 that Applicants seek to place in interference. The '229 Applicants responded by first pointing out that Goodenough et al teach a bromine concentration of 0.01 to 100,000 ppm. They also pointed out a concern that this 100,000 ppm value is too high since Goodenough et al should be limited to 40,000 ppm due to the theoretical solubility of bromine in water, i.e., 4g/100g water. The '229 Applicants then went on to state:

"In contrast, the method of Applicants' invention calls for a specific order of addition, namely preparing a caustic solution comprising a halogen stabilizer, water and an alkali or alkaline earth metal hydroxide, adding bromine to the solution and cooling the solution. Applicants' surprisingly discovered that because of the particular order of addition, their inventive method is not limited by the elemental bromine solubility in water. Therefore, as demonstrated in Example III of the present application, a product concentration as high as 46.8% as bromine or 468,000 ppm can be achieved."

The Examiner agreed with this argument and Claim 10, along with other claims, were allowed.

An abridged copy (copies of references and non-essential correspondence have been removed) of the file history of the '229 patent is provided.

It is submitted that the USPTO should treat similar patentability issues similarly. Since (i) both '229 Applicants and the instant Applicants recite processes with identical addition features and (ii) the '229 Examiner found the '229 addition features distinctive over Goodenough et al, it would be inconsistent to now find that Applicants' claims are not equally distinctive over Goodenough et al for the same '229 reasons. Indeed, any other action would impliedly, if not expressly, undercut the validity of claims in the '229 patent, an action that the USPTO should not take. Applicants' claims, drawn to the same subject matter as the '229 patent, are as patentable as are the '229 claims, and the only proper course of action is the declaration of an interference. If this course is followed, there is not need for discussion concerning pH.

An interference provides a venue for determining both patentability and priority. In an interference, either party is authorized to move under 37 C.F.R. §1.633(a) for judgment against an opponent on the ground that the opponent's claims designated as corresponding to the count are not patentable to the opponent, 37 C.F.R. §1.637(a) provides that if a motion for unpatentability under §1.637(a) is based on prior art, it will be presumed that the asserted prior art is likewise applicable to the moving party's claims. In the instant case, the same prior art is applicable against both parties to the prospective interference.

Also, under 37 C.F.R. §1.641(a), if the administrative patent judge becomes aware of a reason why a claim designated as corresponding to the count may not be patentable, for example by a memo from the Examiner, he may enter an order directing the parties to address the question of patentability. Thus, the ultimate patentability of Claims 61-65 (and the corresponding '229 claims) over Goodenough et al can be explored inter partes and the result of the interference may be an adverse judgment against Claims 61-65 (*see* 37 C.F.R. §1.663) and an adverse judgment against the '229 patent claims (*see* U.S.C. 135(a)).

Thus, the existence of Claims 10-17 in the '229 patent and the prior determination that they are patentable over the same prior art cited against Applicants' Claims 61-65, are in and of themselves sufficient basis to declare the interference.

The Examiner has also rejected Claims 61-65 for the "reasons of record." In the Office Action of June 6, 2001, these claims were rejected under 35 U.S.C. 103(a) as being unpatentable over Goodenough et al, and Hamilton or Henry et al. Hamilton and Henry et al are cited to "add the NaBr...to the process taught by Goodenough." Applicants do not agree that either of these two references is properly combinable with Goodenough et al. The law is clear that a combination or references must be suggested by the references themselves. There is no teaching in Goodenough et al that NaBr is a proper or possible reactant. NaBr, in and of itself, is not a biocide. To obtain biocidal activity, NaBr must be oxidized to provide the bromonium ion. The oxidant is often bleach. The art has long taught this chemistry. Goodenough et al teaches a different chemistry which does not use a bromide, e.g., NaBr, or an oxidant such as bleach. Nowhere in Hamilton or Henry et al is there anything to suggest modification of the Goodenough et al chemistry that is different from theirs. Thus, Hamilton and Henry et al do not cure the deficiencies of Goodenough et al as they cannot be properly combined therewith. The rejection should be withdrawn.

Reconsideration of the rejection under 35 U.S.C. 103(a) on co-pending application 09/732,601 is requested. The Action contends that this co-pending application would constitute prior art under 35 U.S.C. 102(e), if patented. However, attention is invited to 35 U.S.C. 103(c) which states that subject matter developed by another person which qualifies only under one or more of subsections (e), (f), or (g) of Section 102 shall not preclude patentability where the subject matter and the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of an Assignment to the same person. The Action is correct that there is a common Assignee of the cited co-pending application and the present application. The subject matter of Application No. 09/732,601 and the presently claimed invention were at the time the invention was made owned by the same party, Albemarle Corporation, by virtue of employment and